

REMARKS

Claims 1-38 are pending. Claims 3, 5, 7-9, 15-20, 22, 23, 25, 27, 29-35, and 38 remain withdrawn as being non-elected. Claims 1, 2, 4, 6, 10-14, 21, 24, 26, 28, 36, and 37 are the only claims that have been examined on the merits. Of these examined claims, claims 1 and 36 are the only independent claims.

In the Office Action, claims 1, 2, 4, 6, 10-14, 24, 26, 28, and 36 were rejected under 35 U.S.C. § 102(e) based on U.S. Patent No. 6,874,966 to Duqueroie et al. ("Duqueroie").

Applicants respectfully submit that the section 102(e) rejection should be withdrawn because Duqueroie does not disclose the device recited in amended, independent claim 1, or the device recited in independent claim 36.

Independent Claim 1 Is Allowable Over Duqueroie

Applicants respectfully submit that claim 1, as amended, is allowable over Duqueroie because the cited reference does not disclose all of the features recited in claim 1. For example, Duqueroie does not disclose or suggest a device, including, among other features, an applicator including "a first portion configured to contribute to restricting axial movement of the applicator away from [a] case, and a second portion distinct from the first portion, the second portion being configured to contribute to rotationally coupling the applicator to the container . . .," as recited in claim 1.

The Office Action at page 3 refers to reference number 34 of Duqueroie for the asserted disclosure of a first portion. Duqueroie's reference numeral 34 refers to a handle of an applicator 30. Duqueroie lacks any disclosure of the handle 34 being "configured to contribute to restricting axial movement of [an] applicator away from [a]

case,” as recited in amended claim 1. Accordingly, Duqueroie’s handle 34 does not correspond to the “first portion” recited in amended claim 1.

Rather than disclosing the applicator recited in claim 1, Duqueroie shows an applicator 30 having studs 81, which are not the same as, and do not disclose, the first and second portions recited in claim 1. For example, the studs 81 do not constitute the recited “**distinct**” first and second portions having all of the other features recited in claim 1 (emphasis supplied). Since claim 1 recites a “second portion **distinct from** [a] first portion” (emphasis supplied), the studs 81 disclosed in Duqueroie cannot correspond to both the first portion and the second portion recited in claim 1.

For at least these reasons, claim 1 is allowable over Duqueroie.

Independent Claim 36 Is Allowable Over Duqueroie

Applicants respectfully submit that claim 36 is allowable over Duqueroie because Duqueroie does not disclose all of the features recited in claim 36. For example, Duqueroie does not disclose or suggest a device, including, among other features, an applicator “compris[ing] a screw thread configured to engage with [a] screw thread of [a] case,” as recited in claim 36. Duqueroie discloses an applicator 30 that does not have any screw thread. Although, as mentioned above, Duqueroie’s applicator 30 includes studs 81, the studs 81 are not the same as, and do not disclose, the “screw thread” recited in claim 36.

For at least these reasons, claim 36 is allowable over Duqueroie.

Applicants note that the Office Action does not provide any explanation of why claim 36 was rejected. Furthermore, the Office Action does not appear to have any response to Applicant’s remarks in the Reply filed on June 9, 2006 (“Reply”), explaining

why the section 102(e) rejection of claim 36 should be withdrawn. See the Reply at page 3. If the rejection of claim 36 is not withdrawn, Applicants would appreciate a further explanation of the rejection and a response to Applicants' remarks.

Dependent Claims 2, 4, 6, 10-14, 24, 26, and 28 Are Allowable Over Duqueroie

Claims 2, 4, 6, 10-14, 24, 26, and 28 depend from claim 1 and, thus, should be allowable for at least the same reasons claim 1 is allowable. Moreover, at least some of these dependent claims recite features that are not disclosed in Duqueroie. For example, Duqueroie does not have any disclosure of any striation(s), as recited in dependent claims 2 and 6. Contrary to the assertions in the Office Action at page 3, the areas between studs 81 disclosed in Duqueroie do not correspond to the recited striations.

For the Section 103 Rejection, Duqueroie is Not Prior Art

In the Office Action, claims 21 and 37 were rejected under 35 U.S.C. § 103(a) based on Duqueroie in view of U.S. Patent No. 6,726,387 to Dumler et al.

Applicants respectfully submit that the section 103(a) claim rejection should be withdrawn in accordance with 35 U.S.C. § 103(c). **Duqueroie is not prior art under any subsection of 35 U.S.C. § 102 other than § 102(e), (f), and/or (g).**¹ The invention covered by the pending claims and the invention of Duqueroie were, at the time of the invention of the pending claims, owned by L'Oréal or subject to an obligation of assignment to L'Oréal. Accordingly, Duqueroie is disqualified as

¹ Applicants also note that neither the Duqueroie patent nor the present application originated from an international application filing.

prior art under 35 U.S.C. § 103(c), and the section 103 claim rejection should be withdrawn. See M.P.E.P. §§ 706.02(l), 706.02(l)(1), and 706.02(l)(2).

For at least the reasons explained above, the claim rejections should be withdrawn, and claims 1, 2, 4, 6, 10-14, 21, 24, 26, 28, 36, and 37 should be allowed. Moreover, Applicants respectfully submit that withdrawn claims 3, 5, 7-9, 15-20, 22, 23, 25, 27, and 38 should be rejoined and allowed because they depend from one of independent claims 1 and 36.

In addition to amending claim 1, Applicants have made minor amendments to claims 21, 22, and 36 to correct inadvertent typographical mistakes without narrowing the claim scope.

Applicants respectfully request reconsideration of the application and timely allowance of the pending claims.

If the Examiner believes a telephone conversation might expedite prosecution of the application, the Examiner is invited to contact Applicants' attorney (571-203-2774).


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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